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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,453	01/23/2002	Fred Burbank	R0367-02001	5144
7590 Edward J. Lynch DUANE MORRIS LLP ONE MARKET SPEAR TOWER STE. 2000 San Francisco, CA 94105-1312			EXAMINER HOEKSTRA, JEFFREY GERBEN	
			ART UNIT 3736	PAPER NUMBER
			MAIL DATE 05/03/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/056,453

Applicant(s)

BURBANK ET AL.

Examiner

Jeffrey G. Hoekstra

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/14/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 46-63 and 67-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 46-56, 58-63 and 67-75 is/are allowed.
- 6) ☒ Claim(s) 57 is/are rejected.
- 7) ☒ Claim(s) 46, 50 and 63 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/14/2006 has been entered.

### ***Notice of Amendment***

2. In response to the amendment filed on 12/14/2006, amended claim(s) 46, 48-57, 59, 67, 70, and 73 is/are acknowledged. The current rejections of the claim(s) 46-63 and 67-75 is/are *withdrawn*. The following new and reiterated grounds of rejection are set forth:

### ***Information Disclosure Statement***

3. The information disclosure statement(s) (IDS) submitted on 10/10/2006 is/are acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97 and 1.98. Accordingly, the examiner is considering the information disclosure statement(s).

***Specification***

4. The disclosure is objected to because of the following informalities: page 10 contains multiple instances of unreadable text covered by apparent corrections. Applicant is reminded that 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention.
5. Appropriate correction is required.
6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Objections***

7. Claim 46 is objected to because of the following informalities: the positive recitation of "wand; and a" in line 15 appears to be a grammatical and/or typographical error. Applicant may have intended it to read "wand; a". Appropriate correction is required.
8. Claim 46 is objected to because of the following informalities: the positive recitation of "the wand housing" in lines 16-17 appears to lack antecedent basis and may render the claim indefinite. Applicant may have intended it to read "the housing". Appropriate correction is required.
9. Claim 46 is objected to because of the following informalities: the positive recitation of "unit, effective to transfer mechanical power" in line 22 appears to be

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unclear and may render the claim indefinite. As claimed it is unclear whether the motor unit or the securing mechanism is effective to transfer mechanical power. Appropriate correction is required.

10. Claim 50 is objected to because of the following informalities: the positive recitation of "the anchoring mechanism extended into a body of target tissue" appears to be a grammatical and/or typographical error. Applicant may have intended it to read "the anchoring mechanism extends into the body of target tissue". Appropriate correction is required.

11. Claim 63 is objected to because of the following informalities: the positive recitation of "the elongated shaft" in line 2 appears to lack antecedent basis and may render the claim indefinite. Applicant may have intended it to read "the wand". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claim 57 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. Claim 57 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See

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MPEP § 2172.01. The omitted structural cooperative relationships are: the structural relationship between deployable elements (i.e. the side-cutting mechanism and the anchoring mechanism). The Examiner notes claim 57 depends from claims 49 and 47, wherein claim 47 does not positively recite both deployable elements as required structure.

***Allowable Subject Matter***

15. Claims 46-56, 58-63, and 67-75 contain allowable subject matter.
16. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).
17. Claim 57 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
18. The following is a statement of reasons for the indication of allowable subject matter: the prior art does not disclose, teach, or fairly suggest a system for accessing and isolating a patient's target tissue, comprising *inter alia*: a biopsy wand with an operative tissue cutting element that may be electrosurgically operative, an additional operative element that may be an anchoring or side cutting mechanism, a housing, and moving elements within the housing for moving the operative elements; a replaceable drive unit with a recess for the housing that may releasably hold the housing and drive elements for engaging the moving elements in the housing and for operating the

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operative elements; and a motor unit mechanically connected to the drive unit to operate the operative elements.

### ***Response to Arguments***

19. Applicant's arguments, see pages 8-9 filed 12/14/2006, with respect to claims 46-63 and 67-75 have been fully considered and are persuasive. The rejection of claims 46-63 and 67-75 has been withdrawn.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571) 272-7232. The examiner can normally be reached on Monday through Friday, 8:00 a.m. to 5:00 p.m. EST.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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